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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,898	03/22/2004	Michael H.B. Stowell	00-356-D	1941

7590 02/03/2009
McDonnell Boehnen Hulbert & Berghoff LLP
32nd Floor
300 S. Wacker Drive
Chicago, IL 60606

EXAMINER

AKRAM, IMRAN

ART UNIT	PAPER NUMBER
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1795

MAIL DATE	DELIVERY MODE
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02/03/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/805,898	Applicant(s) STOWELL, MICHAEL H.B.	
	Examiner IMRAN AKRAM	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-23 is/are pending in the application.
- 4a) Of the above claim(s) 3,7-9,13-15 and 18-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,4-6,12,16,17 and 20-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 12/9/08 have been fully considered but they are not persuasive.
2. All of the arguments (from pages 12-14) rely on the difference between the product of the combined prior art compound and the product of the applicant's compound. This argument, however, is spurious since what is actually being claimed is the precursor molecule. What products form due to isomerization, lactonization, or photochemical rearrangement is irrelevant. This can be viewed as preamble or intended use language, both of which are not given patentable weight. On page 14, for example, applicant argues that "Anderson does not provide any example or suggestion to use a photofragmentable group" or that "the photofragmentable element taught by Rock for the protecting group in Anderson would render Anderson unsatisfactory for its intended use." Regardless of whether these assertions are true, their merit is moot as it is a composition being claimed and the composition which is rejected via a case of obviousness as dictated below.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 2, 4-6, 10-12, 16, 17, and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson (US 6,437,150 B1) in view of Rock (US 6,022,529).

7. Anderson discloses the use of molecules that undergo photochemical transformation to emit a smell. These molecules contain fragrance precursors (see abstract) and are to be used in topical creams and sprays for human hygiene products (column 12, lines 58-67). One such fragrance molecule is what Anderson refers to as an organoleptic alcohol (see molecule 4 in column 5). This chain has an aroma and is the byproduct of photo-activation. Anderson teaches this molecule to be attached to a variety of ketones, esters, and other oxygen containing organic compounds. And while Anderson discloses many different structures appropriate for photochemical rearrangement, Anderson does not disclose the specific structure of Applicant's species. Rock (and applicant himself), however, discloses a structure identical to applicant's sans the fragrance molecule (see claim 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the composition of Rock with the invention of Anderson. The purpose of Anderson's invention is nearly identical to that of applicant's and the specific structures are known in

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the art. The R¹ group of Rock could be substituted rather easily with the molecule disclosed in Anderson to achieve the same purpose as Anderson. The claim would have been obvious because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Thus all generic claims read on Anderson in view of Rock are rejected, including the elected species.

8. In regards to claim 5 and 6 specifically, Anderson discloses an auxiliary fragrance (column 7, lines 18-25) and column 5 reveals that the original molecule will photorearrange to become a fragrance.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to IMRAN AKRAM whose telephone number is (571)270-3241. The examiner can normally be reached on 10-7 Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexa Neckel can be reached on 571-272-1446. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

IA

/Alexa D. Neckel/
Supervisory Patent Examiner, Art Unit 1795